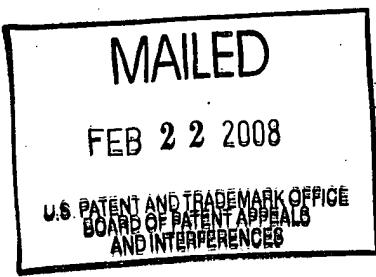


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS E. SAULPAUGH,
GREGORY L. SLAUGHTER, MOHAMED M. ABDELAZIZ
and
BERNARD A. TRAVERSAT

Application 09/653,215

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on February 14, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matter requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Order Returning Undocketed Appeal to Examiner was mailed May 9, 2007 which requested: (1) clarification regarding the status of a possible new ground of rejection involving claim 24; and (2) clarification regarding the status of claims 17-23, 25-39, and 41-47 under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Czerwinski. In response, a new Examiner's Answer was mailed on June 1, 2007 which stated:

In response to the Order Returing [sic] Undocketed Appeal to Examiner, the examiner has withdrawn the rejection of claim 24 as it was inadvertantly [sic] rejected in Examiner's Answer mailed on 12/4/06. Therefore, claim 24 is allowable and is not forwarded for appeal. On the other hand, regarding rejection of claims 17-23, 25-39, and 41-47, clarification has been made to indicate which claims were rejected under U.S.C. 102 and which claims were rejected under U.S.C. 103. Furthermore, a revised ground of rejection has been provided to clearly indicate the ground of rejection applied toward all appealed claims (Claims 1-7, 9-23, 25-39, and 41-47). All grounds of rejection are in accordance with Final Office Action mailed on 4/4/06.

The "Grounds of Rejection to be Reviewed on Appeal," were listed as follows:

1. Claims 1, 2, 5, 6, and 9-16 stand finally rejected under 35 U.S.C. 102(a) as being anticipated by Adams (U.S. Patent 6718,470) [page 2];

2. Claims 3 and 7 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Adams [page 2];
3. Claims [sic] 4 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Czerwinski et al. "An Architecture for a Secure Service Discovery Service" (hereinafter Czerwinski) [page 2];
4. Claims 17, 18, 21, 22, 25-34, 37, 38, and 41-47 stand finally rejected under 35 U.S.C. 102(a) as being anticipated by Adams [page 3]; and
5. Claims 19, 20, 23, 35, 36, and 39 stand finally rejected under 35 U.S.C. 103(a) [as] being unpatentable over Adams in view of Czerwinski [page 3].

The "Response to Argument" section appearing on pages 10-16 agreed with the "Grounds of Rejection to be Reviewed on Appeal" except that claim 24, which was noted by the examiner to be allowable, was inadvertently included in (4) [page 16] and Czerwinski was not included in (5) [page 16]. However, the "Grounds of Rejection" appearing on pages 3-10 do not agree either of these sections. All three of these sections need to be consistent. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the examiner:

- 1) to vacate the Examiner's Answer mailed June 1, 2007;

- 2) to issue a revised Examiner's Answer which contains consistent grounds of rejection in the "Grounds of Rejection to be Reviewed on Appeal," "Grounds of Rejection" and "Response to Argument" sections; and
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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